



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,029	09/26/2003	Ross Katz	3514/5	8044

7590 02/28/2005

Jeffrey A. Pine
BANIAK PINE & GANNON
Suite 1200
150 N. Wacker Drive
Chicago, IL 60606

EXAMINER

HSIEH, SHIH YUNG

ART UNIT	PAPER NUMBER
----------	--------------

2837

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/673,029

Applicant(s)

KATZ, ROSS

Examiner

Shih-yung Hsieh

Art Unit

2837

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 21-23 is/are rejected.
- 7) ☒ Claim(s) 16-20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 2837

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 8-9, and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Silverman (3,672,378).

Regarding claim 8, Silverman discloses a method for manufacturing a flavored pick (pick is defined as something used for picking, including toothpick in the Webster's II New Riverside University dictionary) comprising the steps of:

Creating a flavored mixture including a flavoring agent and a molding material;

Using said mixture in a molding process to manufacture a flavored pick (col. 3, lines 1-4).

Regarding claims 9 and 11, Silverman discloses the claimed invention (col. 2, lines 15-19).

Regarding claim 12, Silverman discloses the claimed invention (col. 1, lines 63-65).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jonathan (4,993,302) in view of Humphrey (4,856,405).

Regarding claim 1, Jonathan discloses a pick (1) except that a flavoring agent located within a portion of said pick.

Humphrey teaches a reed having a flavoring agent located within a portion of said reed (col. 2, lines 27-30) for enhancing the taste when in use by a musician (col. 2, lines 3-7). It would have been obvious to one having ordinary skill in the art to modify Jonathan's pick as taught by Humphrey to include a flavoring agent located within a portion of said pick for the purpose of enhancing the taste when in use by a musician.

Regarding claim 2, Jonathan discloses the claimed invention (col. 2, lines 7-9).

Regarding claims 3-5, Jonathan in view of Humphrey discloses the claimed invention.

Regarding claims 6 and 7, Jonathan discloses the claimed invention including a carrier (3) attached to the surface of a pick (1) except that said carrier containing a flavoring agent.

Humphrey teaches a reed having a flavoring agent located within a portion of said reed for enhancing the taste when in use by a musician. It would have been obvious to one having ordinary skill in the art to modify Jonathan's pick as taught by Humphrey to include a flavoring agent in the carrier for the purpose of enhancing the taste when in use by a musician.

5. Claims 8-9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mackey et al. (5,859,377) in view of Silverman.

Regarding claim 8, Mackey et al. discloses the claimed invention (col. 5, lines 21-35) except the step of creating a flavored mixture including a flavoring agent and a molding material.

Silverman teaches the step of creating a flavored mixture including a flavoring agent and a molding material in manufacturing a pick for providing a user pleasant taste in his mouth (col. 3, lines 3-4). It would have been obvious to one having ordinary skill in the art to modify Mackey et al's method as taught by Silverman to include the step of creating a flavored mixture including a flavoring agent and a molding material for the purpose of providing a user pleasant taste in his mouth.

Regarding claims 9 and 11, Mackey et al. in view of Silverman discloses the claimed invention.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mackey et al. in view of Silverman as applied to claim 8 above, and further in view of Leong (2004/0194607).

Regarding claim 10, Mackey et al. in view of Silverman discloses the claimed invention except that said molding material is a liquid metal.

Leong teaches a molded pick using liquid metal material (page 4, col. 1, lines above claims) for durability. It would have been obvious to one having ordinary skill in

Art Unit: 2837

the art to modify Mackey et al. in view of Silverman's method as taught by Leong to include said molding material is a liquid metal for the purpose of durability.

7. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mackey et al. in view of Humphrey.

Regarding claim 12, Mackey et al. discloses a method of selecting a standard pick (10) except the step of attaching a flavoring agent to said pick.

Humphrey teaches attaching a flavoring agent to a reed for enhancing the taste when in use by a musician. It would have been obvious to one having ordinary skill in the art to modify Mackey et al.'s method as taught by Humphrey to include the step of attaching a flavoring agent to said pick for the purpose of enhancing the taste when in use by a musician.

Regarding claims 13-15, Mackey et al. in view of Humphrey discloses the claimed invention. See above reasoning and Humphrey's col. 2.

8. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mackey et al. in view of Humphrey as applied to claim 12 above, and further in view of Jonathan.


Regarding claims 21-23, see above statement and reasoning.

9. Claims 16-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The claims are allowable over the prior art for at least the reason that the prior art fails to reasonably teach or suggest in claim 16 that said attaching comprises the step of printing on the surface of said pick using a flavored ink as set forth in the claimed combination.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shih-yung Hsieh whose telephone number is 571-272-2065. The examiner can normally be reached on 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Martin can be reached on 571-272-2107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic


SHIH-YUNG HSIEH
PRIMARY EXAMINER